

BEST AVAILABLE COPY



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Offic

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

NA

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/529,480 07/25/00 KIRBY

A 470044.404

EXAMINER

IM52/1107
SEED INTELLECTUAL PROPERTY LAW GROUP
SUITE 6300
701 FIFTH AVENUE
SEATTLE WA 98104-7092

RATIGUELU LI

ART UNIT

PAPER NUMBER

1711
DATE MAILED:

11/07/01

4
#6

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)	
Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on _____.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 165 is/are pending in the application.

Of the above claim(s) 38 and 58-65 is/are withdrawn from consideration.

Claim(s) 1 & 2 is/are allowed.

Claim(s) 9-57 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of References Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

Art Unit: 1711

DETAILED ACTION

1. The numbering of claims is not in accordance with 37 CAR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 38-64 (starting on page 58) have been renumbered as 39-65.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, and 9-57, drawn to a method of dispersing an insoluble material in a solution, classified in class 524, subclass 566.
- II. Claims 3-8 and 58-65, drawn to a method of treatment of a substrate, classified in class 427, subclass 390.

The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MEP. § 806.05(I)).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1711

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Attorney Jim Mesher on September 27, 2001 a provisional election was made with traverse to prosecute the invention of I, claims 1, 2 and 9-57. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-8 and 58-65 are withdrawn from further consideration by the examiner, 37 CAR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

4. This application does not contain an abstract of the disclosure as required by 37 CAR 1.72(b). An abstract on a separate sheet is required. *— submitted. It is OK Jun 06, 2002*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1711

✓6. Claims 15, 16, 24, 25, 26, 27, 29, 32, 46, 47-49, 51 54, and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is vague because it recites Y as a carbon atom, O as a sulfur atom or POR.

How can a carbon atom in the same formula be represented by C and Y?. How can hydrogen in the same formula be represented by R2 and R?. How can a sulfur atom (which in all scientific literature is represented by S) be represented by O?. Meaning of word "residue" is not clear.

Also not clear is word "POR". Does P stand for phosphorus and O for oxygen or sulfur?. What does "R" stand for ?.

Similar comments apply to claims 16, 25, 26, 47 and 48.

Claim 29, 32 and 51 are vague in reciting "agriculturally acceptable salt". What is an agriculturally acceptable salt"?

Claim 27 and 49 are vague since meaning of "will not substantially change" is not clear.

Claim 55 is vague since meaning of "copolymers are in range of 1000 to 90,000 daltons" is not clear.

Claims 24 and 46 are indefinite in containing an improper Markush terminology . The members of the group have to be connected by "and" (not "or" as is done in these claims).

Claims 25 and 26 are indefinite because the recite a group having only one member.

Claim 54 is indefinite in reciting "derivatives" in lines 21 and 22 because it is not known which specific derivatives are envisioned in the scope of this claim.

*withdrawn for
all claims
May 28, 2003*

Art Unit: 1711

7. In response to Examiner's requirements of election of species, the applicants have elected following species:

WKR a. Anhydride as first monomer in claim 1

WKR b. n-octene (as olefin) as second monomer with amide substituent in claim 14

WKR c. Limonene as second monomer in claim 13

WKR d. Methylene cyclopentene as second monomer in claim 1

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

✓ 9. Claims 9-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kataoka et al. (JP 58131903) in view of Fujita et al (JP 62-36302). (See English translations of these references). *withdrawn 05.28.2003*

WKR Kataoka discloses a composition containing a water soluble sodium salt of a sulfonated monolefin and/or ethylenic unsaturated dicarboxylic acid copolymer resin (page 4, paragraph 2 of English translation). Insoluble materials such as bentonite, calcium carbonate are mentioned on page 7, prescription, (I). The copolymers disclosed by patentee *read record* on those that are instantly claimed.

Art Unit: 1711

~~WKR~~ Kataoko does not mention an insoluble material that is useful ^{for} agricultural purposes such as those of instant claim 34.

Fujita discloses an agricultural chemical composition in which insecticides and similar other insoluble materials are used.

It would have been obvious from teachings of Fujita to use the insoluble materials of ~~WKR~~ Fujita as alternate materials in the composition of Kataoka because then Katoka's composition will have agriculturally useful insoluble materials very well dispersed in water due to the ~~WKR~~ presence of copolymers which Kataoka has in its composition.

It is suggested that all claims should be checked to ensure that they meet the requirements of standard formats.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is (703) 308-3224. The examiner can normally be reached on ~~from~~ to .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, can be reached on (703) . The fax phone number for the organization where this application or proceeding is assigned is (703) .

Art Unit: 1711

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) .

UKR
U.K. Rajguru/dh

October 29, 2001

James J. Seidleck
James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700